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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/663,473                          | 09/15/2003  | Kazuhiko Niwa        | 701158-4004         | 2894             |
| 34313                               | 7590        | 09/14/2004           | EXAMINER            |                  |
| ORRICK, HERRINGTON & SUTCLIFFE, LLP |             |                      | SHAW, CLIFFORD C    |                  |
| 4 PARK PLAZA                        |             |                      | ART UNIT            |                  |
| SUITE 1600                          |             |                      | PAPER NUMBER        |                  |
| IRVINE, CA 92614-2558               |             |                      | 1725                |                  |

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,473

Applicant(s)

NIWA, KAZUHIKO

Examiner

Clifford C Shaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-7, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0915.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **Detailed Action**

1.) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.) Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese document no. 8-99181 (cited by applicant). The English abstract and figures 1-4 in the Japanese document no. 8-99181 disclose a welding state detecting system with features claimed, including welding state detecting device and wireless transmitting arrangement at 1 and external receiving means at 4.

3.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.) Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese document no. 8-99181 as applied to claims 5 and 6 above, and further in view of Matuschek et al. (6,072,146). The only aspect of the claims to which the rejection above does not apply is the provision for controlling the resistance-welding machine on the basis of the

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processed data from the sensor. This difference does not patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious to have used the data signals taught by the Japanese document no. 8-99181 for control purposes, the motivation being the teachings of Matuschek et al. (6,072,146) that it is advantageous to use sensed welding state data to control a welding machine (see elements 1, 7, and 8 in Matuschek et al. (6,072,146)).

5.) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese document no. 8-99181 taken with Matuschek et al. (6,072,146) as applied to claims 7 and 12 above, and further in view of Ohmi et al. (6,018,136). The only aspect of the claim to which the rejection above does not apply is the provision for the transmitting and receiving means to use data request signals. This difference does not patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious to have implemented the signal transmission scheme of the combination set forth in paragraph 4 above using any conventional wireless approach. In particular, it would have been obvious to have used a wireless networking approach as taught by Ohmi et al. (6,018,136) (see figure 1, elements 11, 14, and 4 in Ohmi et al.), the motivation being to secure the advantages of wireless networking for the wireless data gathering taught by the Japanese document no. 8-99181. The claimed data request signals would inherently be present in the wireless network taught by Ohmi et al. (6,018,136) since a Local Area Network of the type in Ohmi et al. (6,018,136) must necessarily include data request signals of the type claimed.

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6.) Claims 8-10 are objected to for depending from rejected claims, but would be given favorable consideration if recast in independent form to include all of the limitations of the parent claims. None of the prior art of record teaches or suggests the particular systems with the controlling means and rewriting means as set forth in each of the claims.

7.) Claims 1-4 are allowable over the prior art of record. None of the prior art of record teaches or suggests the particular welding state detecting and wireless transmitting device as set forth in claim 1 with the charging means that utilizes a portion of the welding current. The other claims are allowable at least because they depend from claim 1. In regard to the Japanese document no. 2003-191079, this document is not considered to be prior art since it is by the same inventor as that of the instant application and was published July 8, 2003, within a year of the 9/15/2003 filing date of the instant application.


8.) The Japanese document no. 10-305366 is cited to show prior art wireless monitoring and control of a welding system.

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 571-272-1182. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas G. Dunn, can be reached at 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clifford C Shaw  
Primary Examiner  
Art Unit 1725

September 10, 2004